



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/019,195

06/03/2002

Hans-Jurgen Hannig

LSP-4

6251

20311 7590 01/29/2010

LUCAS & MERCANTI, LLP
475 PARK AVENUE SOUTH
15TH FLOOR
NEW YORK, NY 10016

EXAMINER

MACARTHUR, VICTOR L

ART UNIT

PAPER NUMBER

3679

NOTIFICATION DATE

DELIVERY MODE

01/29/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

info@lmiplaw.com

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/019,195 | Applicant(s) HANNIG ET AL. | |
| | Examiner VICTOR MACARTHUR | Art Unit 3679 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 10/21/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 June 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation that a single “space is provided between the second hook projection... and the first leg... the space extending between an inside surface... and an end of the second panel” (lines 25-29 of claim 39) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Note that the originally presented elected species as shown in figure 3 sets forth two spaces (L1 and L2) one of which (L1) extends between the second hook projection (5f) and the first leg (4e) in the vertical direction; and the other of which (L2) extends between the inside surface (13) and the end (5h) of the second panel in the horizontal direction. Figure 3 does not set forth a single space that extends between all claimed surfaces in a single direction as claimed.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet”

Art Unit: 3679

pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter that a single “space is provided between the second hook projection... and the first leg... the space extending between an inside surface... and an end of the second panel” (lines 25-29 of claim 39), as is further detailed in the objection to the drawings above. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Every element recited in the claims must be described in the written description with reference characters regarding the drawings; or those features must be deleted from the claims.

Claim Objections

Claim 39 is objected to because of the following informalities:

- The claims must be amended to specify whether the phrase “mutually oppositely disposed retaining profiles on said first panel” (lines 4-5 of claim 39) is meant to refer to the previously recited “oppositely disposed retaining profiles arranged at the edges of a first panel” (line 2 of claim 39) or to additional profiles of the first panel not previously recited.
- The claims must be amended to specify whether the phrase “similar retaining profiles [of second panel]” (lines 5-6 of claim 39) are meant to refer the previously recited

Art Unit: 3679

- "oppositely disposed retaining profiles arranged at the edges of a second panel" (lines 3-4 of claim 39) or to additional profiles of the second panel not previously recited.
- The claims must be amended to specify which of the previously recited "oppositely disposed retaining profiles" (line 2 recitation, or line 3 recitation, or line 4 recitation, or lines 5-6 recitation), if any, the phrase "said oppositely disposed retaining profiles" (line 7 of claim 39) is meant to refer to.
 - The claims must be amended to specify which, if any, of the plurality of "the edges of a first panel" (lines 2-3 of claim 39) the singular phrase "the edge of said first panel" (line 10 of claim 39) is meant to refer.
 - The claims must be amended to specify which, if any, of the plurality of "the edges of a second panel" (lines 3-4 of claim 39) the singular phrase "the edge of said second panel" (line 14 of claim 39) is meant to refer.
 - The claims must be amended to specify which of the previously recited edges of the first panel, if any, "the edge of the first panel" (line 23 of claim 39) is meant to refer.
 - The claims must be amended to specify which of the previously recited edges of the second panel, if any, "the edge of the second panel" (lines 26-27 of claim 39) is meant to refer.
 - The limitation that a single "space is provided between the second hook projection... and the first leg... the space extending between an inside surface... and an end of the second panel" (lines 25-29 of claim 39) is not set forth in the originally presented and elected species, as is further detailed in the objection to the drawings above.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 39 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has not pointed out where the amended claim is supported, nor does there appear to be a written description of the claim limitation in the application as filed such that this newly added limitation constitutes new matter. Specifically, the limitation that a single “space is provided between the second hook projection... and the first leg... the space extending between an inside surface... and an end of the second panel” (lines 25-29 of claim 39) was not present in the originally presented invention. Note that the originally presented elected species as shown in figure 3 sets forth two spaces (L1 and L2) one of which (L1) extends between the second hook projection (5f) and the first leg (4e) in the vertical direction; and the other of which (L2) extends between the inside surface (13) and the end (5h) of the second panel in the horizontal direction. Figure 3 does not set forth a single space that extends between all recited surfaces in a single direction as claimed.

Art Unit: 3679

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 39-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear how applicant's originally disclosed invention can have a limitation that a single "space is provided between the second hook projection... and the first leg... the space extending between an inside surface... and an end of the second panel" (lines 25-29 of claim 39) must be shown or the feature(s) canceled from the claim(s). Note that the originally presented elected species as shown in figure 3 sets forth two spaces (L1 and L2) one of which (L1) extends between the second hook projection (5f) and the first leg (4e) in the vertical direction; and the other of which (L2) extends between the inside surface (13) and the end (5h) of the second panel in the horizontal direction. Figure 3 does not set forth a single space that extends between all claimed surfaces in a single direction as claimed.

For the reasons mentioned in the objections and rejections above a great deal of confusion and uncertainty exists as to the proper interpretation of the claim limitations. In accordance with the MPEP § 2173.06, rejection under 35 U.S.C. 102 and 35 U.S.C. 103 follows based on the examiner's best understanding of the claim scope. The applicant is strongly urged to carefully review the entirety of the claims and correct any additional clarity issues not noted above such that the claims fully conform to current U.S. practice.

Art Unit: 3679

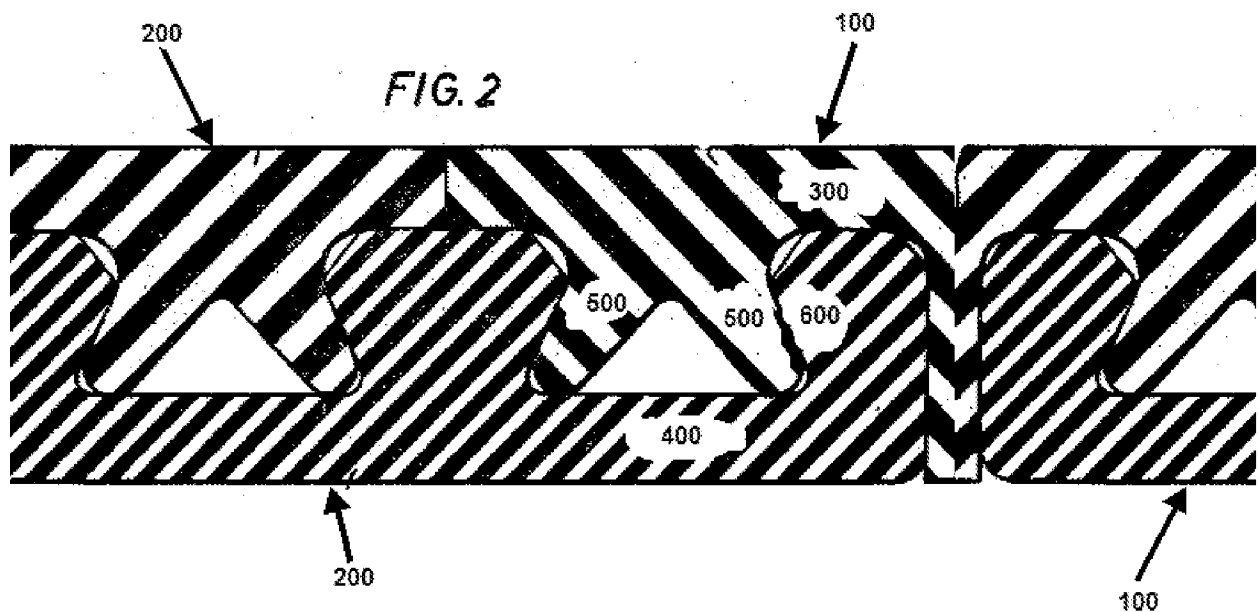
Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 39-45 (as best understood by the examiner, see 35 U.S.C. 112 rejections above) are rejected under 35 U.S.C. 102(b) as being anticipated by Hoffmann USPN 3731445 (see marked-up figure below).



The prior art discloses applicant's claimed fastening system structure (as best understood by the examiner, see 35 U.S.C. 112 rejections above) to include a first panel (100) having a first hook projection (500), first leg (300) and inclined retaining surface (surface of 500 contacting 600); a second panel (200) having a second hook projection (600), second leg (400) and inclined retaining surface (surface of 600 contacting 500); there being a gap-free floor surface (where top

Art Unit: 3679

surface of 100 meets top surface of 200), there being a space (space extending between 600 and 300; and also extending between 600 and 500), in as much as applicant's own elected species does (see 35 U.S.C. 112 rejections above).

Claim Rejections - 35 USC § 103

Claims 33-41, 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Choppe, FR-2,278,876, in view of Wilson, 2,430,200.

Regarding claim 33, Choppe discloses, in the figures unlabeled, a fastening system comprising a first panel **1** and a second panel **1** (see English abstract which uses the term "tiles" thus there are at least two tiles). At least one pair of oppositely disposed retaining profiles is arranged at edges of the first panel and the second panel. The oppositely disposed retaining profiles complement each other. The oppositely retaining profiles of the first panel and the second panel comprise complementary hook elements **E** that hook one into the other. The complementary hook elements comprise a first hook projection **E** and a second hook projection **E**. The first hook projection is connected to the first panel by a first leg on an upper portion of the edge of the first panel. The first hook projection has an inclined retaining surface. The first hook projection is reduced from a free end of the first hook projection towards the first leg. The second hook projection is connected to the second panel by a second leg on a lower portion of the edge of the second panel. The second hook projection has an inclined retaining surface such that the second hook projection is reduced from a free end of the second hook projection towards the second leg. In an assembled condition, the inclined retaining surface of the first hook projection bears against the inclined retaining surface of the second hook projection. The first

Art Unit: 3679

hook projection, connected to the first panel by the first leg on the upper portion of the edge of the first panel, bears against the second leg connected to the second panel at the lower portion of the second panel. However, Choppe fails to disclose a space provided between the second hook projection connected to the second panel by the second leg on the lower portion of the edge of the second panel and the first leg connected to the first panel at the upper portion of the first panel.

- Wilson teaches, in Figure 2, a space **A1** (see marked-up attachment; col. 20-24) provided between a second hook projection **11** connected to a second panel **1** by a second leg **10** on a lower portion of an edge of the second panel **1** and a first leg **2** connected to a first panel **4** at an upper portion of the first panel **4**.
- Wilson does not explicitly state the reason for the space but the knowledge generally available to one of ordinary skill in the art would include recognition that that such a space would allow for placement of adhesive therein to better prevent the panels from being separated from each other.
- MPEP 2144 clearly states that “The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art **or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law**” (emphasis added).
- Applicant’s disclosure, and all other evidence of record, fails to set forth any unexpected result due to any specific size, shape, or location of the space over any

Art Unit: 3679

other size, shape or location. Accordingly, the claimed space size, shape, and location of the space lack any criticality.

- MPEP 2144.04 states "**If the applicant has demonstrated the criticality** of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection" (emphasis added). However, as noted above there is currently no evidence on record showing criticality (unexpected results) such that a rejection based solely on case law is appropriate.
- Note that MPEP 716.01(c)(II) states that "The arguments of counsel cannot take the place of evidence in the record". Note that MPEP 716.02 states "Evidence must show unexpected results... burden on applicant to establish results are unexpected and significant... applicants have burden of explaining proffered data... expected beneficial results are evidence of obviousness".
- It has generally been recognized that a change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).
- It has generally been recognized that a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).
- It has generally been recognized that the rearranging of parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.
- "[T]he results of **ordinary innovation** are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the

Art Unit: 3679

progress of useful arts. See U.S. Const., Art. I, section 8, cl.8.” In re KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007) (emphasis added).

Accordingly, changing a trivial detail of the prior art (such as the size, shape or location of a space) is at best an “ordinary innovation” if any innovation at all, and therefore does not constitute sufficient reason for patentability.

- Therefore, as taught by Wilson, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a space between the second hook projection connected to the second panel by the second leg on a lower portion of the edge of the second panel of Choppe and the first leg connected to the first panel at an upper portion of the first panel to allow space for adhesive thus insuring the two panels to be permanently joined, by rational derived from both the knowledge of one of ordinary skill in the art, and prior case law as detailed above.

Regarding claim 40, given the modification, the first leg would have projected approximately perpendicular from the edge of the first panel. The first hook projection would have faced towards the underside of the first panel. The second leg would have projected approximately perpendicular from the opposite edge of the second panel. The second hook projection would have faced towards the top side of the second panel.

Regarding claim 41, given the modification, the inclined retaining surfaces of the hook projections would have engaged each other such that the complementary hook projections hook one into the other only by elastic deformation.

Art Unit: 3679

Regarding claim 44, Choppe, as modified, fails to disclose the panels made substantially of MDF, HDF, or chipboard material. Applicants are reminded that making panels of MDF, HDF, or chipboard material is an obvious modification to resist wear. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the panels of MDF, HDF, or chipboard material to prolong the panels from wearing.

Claims 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Choppe, FR-2,278,876, in view of Wilson, 2,430,200, as applied to claims 39-41 and 44, and further in view of Moriau et al., 6,006,486.

Regarding claim 42, Choppe, as modified, discloses an end of the first hook projection at an under portion of the first panel bearing against the second panel at least in a region of an upper portion of the edge of the second panel. However, Choppe fails to disclose a clearance provided between an end of the second hook projection at the lower portion of the second panel and the edge of the first panel. Moriau et al. teach, in Figure 8, a clearance (near “12”) provided between an end of a second hook projection **47** at a lower portion of the second panel and an edge of a first panel **8** to allow inclusions such as dust to be inserted such that the panels are engaged without the inclusions exerting an adverse influence upon the engagement of the panels (col. 11, line 66, to col. 12, line 4). Therefore, as taught by Moriau et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a clearance between the end of the second hook projection at the lower portion of the second panel and an edge of the first panel to allow inclusions to be located during engagement of the panels thus providing a good engagement between the panels.

Art Unit: 3679

Regarding claim 43, Choppe, as modified, fails to disclose intermediate spaces between the panels forming adhesive pockets. Moriau et al. teach, in Figure 8, intermediate spaces (19:20, 12:14) between the panels forming adhesive pockets to allow adhesive to be inserted (col. 4, lines 5-6). Therefore, as taught by Moriau et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide intermediate spaces between the panels forming adhesive pockets to allow the two panels to be inserted.

Response to Arguments

Applicant's arguments with regard to the claim rejections have been fully considered but they are not persuasive.

Specifically, applicant argues that the newly added limitation to claim 39 “the space extending between an inside surface of the first panel and an end of the second panel” overcomes the prior art. This is not persuasive since, as noted in the objections and 35 U.S.C. 112 1st and 2nd paragraph rejections above, the term "inside surface" is at best an unclear recitation of a surface merely disposed between some other elements; and at worst new matter. Furthermore, though applicant's intended scope is unclear, it appears that either interpretation of the claims would be met by the prior art as is detailed in the new grounds of rejection above.

Conclusion

Applicant's amendment (i.e., the newly added limitation “the space extending between an inside surface of the first panel and an end of the second panel” in the last two lines of claim 39) necessitated the new grounds of rejection presented in this Office action, since the term renders

Art Unit: 3679

the claims unclear necessitating speculation as to what the intended scope of the claims is, and application of new art on the new scope as best understood by the examiner. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

Art Unit: 3679

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

January 27, 2010

/Victor MacArthur/
Primary Examiner, Art Unit 3679